

REMARKS

Reconsideration of this application is respectfully requested.

This application has been reviewed in light of the Office Action dated October 20, 2005. Claims 1-14 and 17-18 are currently pending in the application. Claims 1, 14 and 17 have been amended. Support for these amendments is provided at paragraphs 0003 and 0028. Claims 15 and 16 have been cancelled. Claim 18 has been added. Adequate support for Claim 18 is disclosed in at least paragraphs 0002, 0073 and 0139-0140. Therefore, it is respectfully submitted no new matter has been added with the addition of Claim 18.

Claims 1 and 14 were rejected under 35 USC 112, second paragraph, as being indefinite for failing to particular point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner stated "[t]he term 'competent' in claim 1 and 14 is a relative term which renders the claim indefinite".

Claims 1 and 14 have been amended to read "national administrative department responsible for examining the application and registering the trademark". Support for these amendments is disclosed in paragraphs 0003 and 0028. The term "national administrative department" refers to the single appropriate national agency responsible for prosecuting and registering trademarks such as the French Patent Office or the U.S. Patent and Trademark Office. Therefore, it is respectfully submitted the amendments to Claims 1 and 14 overcome the 35 USC 112, second paragraph, rejection.

Claims 1-17 were rejected for the reasons set forth in the Office Action dated October 20, 2005 on pages 3-14.

Claims 1, 14 and 15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Berke (U.S. Patent No. 6,629,092) in view of Coakley (US2002/019416) and further in view of Tran (US2001/0049707). In regards to Claims 1 and 14, the Examiner asserted

“Berke teaches a process for registering a trademark by means of a local computer (Fig. 2:4) connected to a remote computer (Fig. 2: 8) via computer Internet network (Fig. 2:6)(column 4, lines 58-65) performing the following steps in order: entering the trademark (columns 3 & 4, 30-32 & 15-19); selecting the products or ‘goods’ to which the trademark applies (column 3, lines 30-32); validating the entry and selection (column 3, lines 32-36); sending (storing) the validated entry and selection to the remote computer (column 3, lines 36-38) via the network (column 3, lines 19-25)”.

The Examiner admitted that “Berke does not specifically teach wherein the selecting of products or ‘goods’ was from at least one official class of products and services”. However, the Examiner asserted

“[i]t would have been obvious to one of ordinary skill in the art at the time of the invention for Berke to have used a[n] official class of products and services, because Coakley teaches using the official class was an internationally recognized standard for classing products and services of a trademark (Page 2: Paragraph 0015) and would be an ‘accurate’ database as described in Berke (column 6, lines 52-57)”.

The Examiner also admitted that “Berke does not teach” wherein the registered trademark was to be filed at a competent administrative department. However, the Examiner asserted that “Tran teaches filing the trademark application with a national patent office”.

In regards to dependent claim 15, the Examiner asserted

“Tran teaches providing intellectual property attorneys...at a remote computer (Fig. 1:110) for reviewing (Page 10: Paragraph 0090) trademark registration applications...[I]t would have been obvious to one of ordinary skill in the art at the time of the invention for Berke to have provided an offsite intellectual property attorney for reviewing the trademark application, because Tran teaches that said review enhances the member's work product (Page 10: Paragraph 0090)...”

Berke is directed to a search engine system, server and method for providing a user with information related to a particular company or entity. Berke enables a user of the search engine to enter a known trademark and associated goods and/or services of the trademark and returns to the user specific information related to the owner of the known trademark, instead of returning a plurality of 'hits' as with conventional search engines. The returned specific information may be the trademark owner's website, a constructed website for the trademark owner or a list of authorized vendors for the products and/or services of the trademark owner. Furthermore, the search engine system of Berke allows a trademark owner to “register” the trademark and its associated goods with the search engine to add a record in the database of the search engine. Berke clearly does not prepare an application for registering a mark with a competent administrative department, for example, an appropriate national agency, such as the French Patent Office or the U.S. Patent and Trademark Office.

Coakley is directed to a trademark brokerage system for facilitating the brokering of trademarks between trademark owners and potential trademark buyers. A potential trademark buyer using the system of Coakley will enter a search request consisting of a description of the desired goods or services or a particular trademark classification. If any trademarks within the trademark brokerage database satisfy the search request, the buyer will

be presented with a list of trademarks available for sale.

Tran is directed to a system and method for generating intellectual property documents, e.g., a patent application, copyright application, or trademark application. The document drafting system of Tran assists an inventor or applicant in the preparation and filing of intellectual property documents without the need of an intellectual property attorney.

Claim 1 of the instant application is directed to a process “for preparing a trademark registration application to be filed at a national administrative department responsible for examining the application” including the steps of, inter alia, “(i) entering the trademark to be filed at the national administrative department, (ii) selecting the products or services to which the trademark applies from at least one official class of products and services, (iii) validating the entry and the selection, (iv) sending the validated entry and selection to the remote computer via the computer network, the remote computer being disposed on a premises of an intellectual property attorney for reviewing the trademark registration application, and (v) retransmitting the validated entry and selection from the premises of the intellectual property attorney to another remote computer to enable the application to be prosecuted at the national administrative department, said steps being carried out in the order indicated” (emphasis added). The process of Claim 1 facilitates the preparation of a trademark application by allowing an applicant to select products or services from known official classes of products and services. By enabling the applicant to select products or services from known official classes, the products and services enumerated by the process of Claim 1 should be accepted by the national administrative departments, e.g., corresponding trademark offices, responsible for examining the trademark applications with a view to nationally or internationally registering the trademark in the application (see instant

application paragraphs 0008-0013, 0028 and 0059). The applicant of the trademark application will then send the validated entry of the trademark and selection of goods and services to a remote computer of an intellectual property attorney for review, who will then transmit the application to the national administrative department. By having the applicant perform the entering, selecting and validating steps, the process of Claim 1 will reduce the overall expense of the trademark application process to the applicant.

Neither the search engine of Berke nor the brokerage system of Coakley have anything to do with the preparation of a trademark registration application “to be filed at a national administrative department responsible for examining the application” as recited in Claim 1. A skilled artisan would not be motivated to combine these references to create a process for facilitating the preparation of a trademark registration application which would most likely be accepted by the administrative departments responsible for examining the trademark applications.

Furthermore, Tran does not disclose “sending the validated entry and selection to the remote computer via the computer network, the remote computer being disposed on a premises of an intellectual property attorney for reviewing the trademark registration application”. While the system of Tran discloses providing “access to a network of IP lawyers for assisting in finalizing the application” (page 2: paragraph 0019), Tran does not disclose sending the IP lawyers the entry and selection, i.e., the trademark application. Tran provides access by providing links to IP lawyers via its portal. Nowhere in Tran is it disclose to send the application to the IP lawyers. Referring to page 10, paragraph 0090, Tran states:

“A network of independent patent attorneys can perform value-added pre-filing check to enhance the member's work product, if desired. Information relating to the network of attorneys will be maintained in a searchable database. Thus, members can search

by the attorney's specific expertise (legal as well as technical) and by location. Members can then email the selected attorney a question. To prevent conflict issues, the members will be warned that the first question should be couched abstractly so that the invention is not revealed. Further, each attorney in the network automatically observes the applicable conflict rules in his or her jurisdiction before taking on the question. One or more attorneys in the network can respond to the first question to initiate the consultation process, if no conflict exists. The parties can then negotiate fees relating to subsequent questions and/or work. As such, the portal supports a market-based system for getting qualified IP assistance. (*Emphasis added*)

Tran only discloses emailing a question to the IP lawyers not emailing the “validated entry and selection” nor does Tran disclose an IP lawyer reviewing the “validated entry and selection”.

Even further, Tran does not disclose “retransmitting the validated entry and selection from the premises of the intellectual property attorney to another remote computer to enable the application to be prosecuted at the national administrative department”. Tran discloses electronic filing of a patent application at page 5, paragraphs 0048 and 0049. However, Tran only discloses filing the application from the applicant or from the applicant’s computer running the software of Tran’s system (see page 4, paragraph 0041). Tran does not disclose transmitting the application (or document generating as intended by the system of Tran) to an IP attorney and then from the IP attorney to the appropriate national administrative department, i.e., national Patent or Trademark Office.

Therefore, it is submitted respectfully that Claim 1, along with dependent claims 2-13 and 17, are patentably distinct and not rendered obvious over Berke in view of Coakley and further in view of Tran.



Similarly, Claim 14 is directed to a process "for preparing a trademark registration application to filed at a national administrative department responsible for examining the application" including the steps of, inter alia,

"(viii) sending the validated entry and selection to the remote computer via the computer network, the remote computer being disposed on a premises of an intellectual property attorney for reviewing the trademark registration application, (ix) retransmitting the validated entry and selection from the premises of the intellectual property attorney to another remote computer to enable the application to be prosecuted at the national administrative department, said steps being carried out in the order indicated".

For at least the same reasons as described above in relation to amended Claim 1, it is submitted respectfully that amended Claim 14, along with dependent claim 18, is patentably distinct and not rendered obvious over Berke in view of Coakley and further in view of Tran.

In view of the preceding remarks, it is respectfully submitted that all pending claims, namely claims 1-14 and 17-18 are in condition for allowance. Should the Examiner believe that a telephone conference or personal interview would facilitate resolution of any remaining matters, the Examiner may contact Applicants' attorney at the number given below.

Respectfully submitted,

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